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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,160

09/26/2005

Ralf Ulrich

P0-7856/LcA 36,229

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08/05/2010

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Law & Intellectual Property Department
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EXAMINER

USELDING, JOHN E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,160	Applicant(s) ULRICH ET AL.	
	Examiner John Uselding	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/2010 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1-3, 5, 8, 9, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hess et al. (4,100,224).

Regarding claims 1-3, 5, and 9: Hess et al. teach a composition comprising 5-20% (column 2, lines 30-34) polyamide (column 4, lines 55) and 0.5-10% ethylene-vinyl acetate with vinyl acetate contents of 50-80%, 60-75% (column 2, lines 35-40), and 70% (column 8, lines 45-49). The ethylene-vinyl acetate is uncured and in a pure form. The range taught with respect to components a and b significantly overlap and anticipate the

claimed ranges. Hess et al. teach nanoscale fillers that are oxides and oxide hydrates of metals (column 7, lines 1-6).

Regarding claim 8: Hess et al. teach phyllosilicates such as talc, kaolin, and mica (column 7, lines 1-6).

Regarding claim 13: Hess et al. teach a method of producing moldings comprising the step of coating (column 7, lines 15-64).

Regarding claim 14: Hess et al. teach a molding (column 7, lines 15-64).

Claim Rejections - 35 USC § 103

Claims 1-3 and 5, 6, and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrus et al. (2003/0008158).

Regarding claims 1-3, 5, and 8-10: Carrus et al. teach a composition comprising ethylene-vinyl acetate as a polymer with polar groups [0016]. Carrus et al. teach that that polymer has a vinyl acetate content of 18 to 80% [0031], greater than 80% [0032], and 40% [0184]. The ethylene-vinyl acetate is uncured and in a pure form. Carrus et al. teach that their can be a mixture of polymers containing polar groups [0016] and that another type of polymer containing polar groups is polyamide [0027]. Carrus et al. teach using 5 phr of montmorillonite [Examples 1, 2, and 4]. Montmorillonite is a nanoscale filler that is a phyllosilicate and a hydrated sodium calcium aluminum magnesium silicate hydroxide (oxide hydrate of metals).

Carrus et al. fail to specifically teach mixing ethylene-vinyl acetate with polyamide.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use ethylene-vinyl acetate, as was done in the examples, and select polyamide to provide a mixture of polymers containing a predetermined quantity of polar groups. When mixing two components with the same function the skilled artisan would immediately envisage a 50/50 mixture of the two, which anticipates the claimed ranges.

Regarding claim 6: Carrus et al. teach that that ethylene-vinyl acetate has a vinyl acetate content of greater than 80% [0032; claim 8], which anticipates the claimed range.

Regarding claim 11: Carrus et al. teach an example where the components are metered separately [0095]. There is no other option besides metering together or separately. Every method will anticipate this claim.

Regarding claim 12: Carrus et al. teach melt compounding the constituents [0091-0097]. It would have been obvious to incorporate the ethylene-vinyl acetate in the form of a pellet for easier measuring and processing. Most commercial polymers, such as Elvax 40L03 used by Carrus et al., are sold in the form of pellets.

Regarding claim 13: Carrus et al. teach a method of making moldings, films, and hollow articles comprising extruding [0086, Examples].

Regarding claim 14: Carrus et al. teach making cables comprising their composition [0086, Examples], which can be considered a hollow article as a whole or a molding or film considered in respect to the coating layer.

Claims 1-3, 5-6, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. (4,284,550).

Regarding claims 1-3, 5, 9, and 10: Mizuno et al. teach a composition comprising ethylene–vinyl acetate that has a vinyl acetate content of greater than 50%, 60-90%, 70%, and 60% (column 4, lines 39-52). The ethylene-vinyl acetate is uncured and in a pure form. The ethylene vinyl acetate is 1-30 parts (column 4, lines 66-68) and an examples are taught using 10 parts by weight per 100 parts of PBT (Examples 2 and 7). Mizuno et al. teach that up to 40% of the PBT is replaced by polyamide. This provides an overlapping range to that which is claimed of the total of components a and b. Mizuno et al. teach 0.1 to 20 parts of nanoscale fillers that are oxides of metals (column 3, lines 45-65). It would have been obvious to optimize the amount of filler depending on the desired flame retardance.

Mizuno et al. fail to teach the same ranges as claimed.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the overlapping portion, of the range taught in the prior art and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

Regarding claim 6: Mizuno et al. teach a vinyl acetate content of 60-90% is particularly preferred (column 4, lines 39-44). 60-90% significantly overlaps the claimed range of 80-90%.

Regarding claim 11: Mizuno et al. teach a process of melt blending the components wherein the components are metered together (Examples 1 and 7). There is no other option besides metering together or separately. Every method will anticipate this claim.

Regarding claim 12: Carrus et al. teach melt compounding the constituents (Examples). It would have been obvious to incorporate the ethylene-vinyl acetate in the form of a pellet for easier measuring and processing. Most commercial polymers, such as EVATHLENE 310P, are sold in the form of pellets.

Regarding claim 13: Mizuno et al. teach a method of producing molding (column 5, lines 32-36) comprising the step of extruding (column 5, lines 18-26).

Regarding claim 14: Mizuno et al. teach a molding (column 5, lines 32-36; Examples).

Claim 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al. (4,100,224) as applied to claim 1 above.

While Hess et al. teach a vinyl acetate content of 50 to 80% (column 2, lines 35-39) they fail to teach the same range as claimed.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the overlapping portion, of the range taught in the prior art and the range claimed by the

applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

Response to Arguments

Applicant's arguments filed 7/29/2010 have been fully considered but they are not persuasive.

The Applicant has made the argument that Hess and Mizuno fails to teach a nano-scale filler. Hess and Mizuno teach the same fillers as the Applicant uses. The word “nano-scale” is a very broad term. It is noted that the features upon which applicant relies (i.e., particles whose linear dimension in a selectable direction is less than 1 micrometer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant has alleged that Carrus teaches away from the combination of EVA and polyamide. Carrus uses the word alternatively to describe other types of polymers that can be used as the polymer containing polar groups. This does not mean that Carrus teaches that these can never be combined. Carrus never teaches that two polymers containing polymer groups cannot be combined. Contrary to the Applicant's assertions the courts have ruled that the combination of alternative two components that serve the same purpose is obvious. It is obvious to combine separately taught prior art ingredients which perform the same function; it is logical that they would produce the same effect

and supplement each other. *In re Crockett* 126 USPQ 186. There are other definitions provided for the word alternatively such as: “offering or expressing a choice”. The Applicant may not pick one definition from many and then read it into the prior art to suit their argument. It was admitted that Carrus fails to teach the specific mixing of the polymers and that is why it is an obviousness rejection.

Conclusion

This is a Request for Continued Examination of applicant's earlier Application No. 10/525160. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Uselding whose telephone number is (571)270-5463. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1796

/JU/
Examiner
Art Unit 1796